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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/892,790	06/28/2001	Ki-Ook Park	P56525RE	1084
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8439 7590 01/18/2002

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EXAMINER

TUPPER, ROBERT S

ART UNIT

PAPER NUMBER

2652

DATE MAILED: 01/18/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/892,790

Applicant(s)

PARK ET AL.

Examiner

Robert S Tupper

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 28 June 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-51 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-20 is/are allowed.
- 6) ☒ Claim(s) 21-51 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 28 June 2001 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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The amendments to the specification and claims made in the preliminary amendment of 6/28/01 do not comply with 37 CFR 121(b). All additions must be underlined and deletions bracketed. This must be done in the "clean copy" since these are to be printed as such in the reissue patent. Correction is required.

2. Claims 21-51 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

The following limitations have been omitted from the newly presented reissue claims: "first and second projections" defining "first and second air bearing surfaces" (claims 21, 31, and 42); "arcuate front wall portion" (claims 21 and 31), and "third and fourth air bearing surfaces" (claim 21).

In the amendment of 12/01/98 in the parent application Applicant specifically argued (see remarks on pages 11-12) the following structural features to defined over the 102 rejection based upon CHAPIN et al (5,200,868): (a) an arcuate front wall", (b) third and fourth air bearing surfaces, and (c) four separate air bearing surfaces.

3. Claims 31-41 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 31, on line 2, "direction of flight of said slider" is indefinite, confusing, misleading, and misdescriptive. There is no definition of "direction of flight" in the specification. This is not a common term in the art. It is unclear what orientation is involved.

Further, in claim 41, on line 1, "claim 21" appears to be a "typo".

4. Claims 21-51 are rejected under 35 USC 112, first and second paragraphs, as the claimed invention is not described in such full, clear, concise, and exact terms as to enable any person skilled in the art to make and use the same, and/or for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

The original disclosure showed only slider configurations with two separate front air bearing surfaces and a U-shaped cross rail with a side extension on each side

terminating near the rear edge with an air bearing surface. There is NO disclosure of other configurations. These are clearly critical features.

These claims are inadequately disclosed under 112 par.1 if read literally to encompass slider configurations not having All of these critical features.

Alternatively, these claims are indefinite and incomplete for failing to recite all of the critical features.

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 21, 28, 29, 31, 32, 39, and 40 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by CHAPIN et al (5,200,868).

Note the embodiment of figure 3h. CHAPIN et al shows a slider with a U-shaped platform forming a negative pressure cavity 28, the U-shaped platform having a cross rail 24 having side wall portions 20',22' that have an arcuate section and terminate before the rear edge of the slider. This embodiment also has first and second air bearing surfaces 20,22 with front tapered sections 25,27. The first and second air bearing surfaces have portions that are upstream from the U-shaped platform (note these claims do not require the entire air bearing surfaces to be upstream)

7. Claims 21, 30-32, and 41 are rejected under 35 U.S.C. 102(a) as being clearly anticipated by NEPELA et al (5,568,981).

Note figures 4b, 4c, 5b, 5c, and 5d. NEPELA et al shows a slider with a U-shaped platform with a negative pressure cavity (not numbered) behind a cross rail 98 having side wall portions (not numbered) that have an arcuate section and terminate before the rear edge of the slider, and a rear center platform 90 for mounting the transducer.

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 22, 23, 30, 33, 34, and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over CHAPIN et al (5,200,868).

Note the embodiment of figure 3h. As explained above, CHAPIN et al shows a slider substantially as claimed.

CHAPIN et al differs in not utilizing (A) a gap in the cross rail (re claims 22 and 33), (B) a center location for the gap (re claims 23 and 34), and (C) a rear island for mounting the transducer (re claims 30 and 41).

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Concerning (A) and (B), CHAPIN et al shows the use of a centered gap in the cross rail in figures 4a, 4e, and 5d. CHAPIN et al notes (see column 7 line 60 – column 8 line 4) the advantages for this. It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize a centered gap in the cross rail in the embodiment of figure 3j. The motivation is as follows: CHAPIN et al states that the various features disclosed can be combined (see column 10 lines 36-42).

Concerning (C), CHAPIN et al shows the use of a separate rear platform for the transducer in figure 3j. CHAPIN et al notes (see column 2 lines 48-51 and column 7 lines 7-39) the advantages for this. It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize a separate rear platform mounting the transducer in the embodiment of figure 3h. The motivation is as follows: CHAPIN et al states that the various features disclosed can be combined (see column 10 lines 36-42).

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The references cited, but not used in rejections were cited in the prosecution of the parent application..

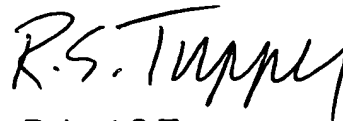
11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert S Tupper whose telephone number is 703-308-

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1601. The examiner can normally be reached on Mon - Fri, 6:00 AM - 3:30 PM (first Fri off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hoa Nguyen can be reached on 703-305-9687. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9314 for regular communications and 703-872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4750.



Robert S Tupper  
Primary Examiner  
Art Unit 2652

rst  
January 10, 2002